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10/724,799	12/01/2003	Thomas Hanna	2002P16048US	5524

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPT.
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EXAMINER

WHIPPLE, BRIAN P

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2152

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/724,799	Applicant(s) HANNA ET AL.	
	Examiner Brian P. Whipple	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-7 and 21-31 are pending in this application and presented for examination. Claims 1-3 and 5-7 have been amended, Claims 8-20 have been cancelled, and Claims 21-31 have been newly added by Applicant's amendment filed on 5/15/08.

Response to Arguments

2. Applicant's arguments, see page 6, filed 5/15/08, with respect to the rejections under section 112 have been fully considered and are persuasive. The 112 rejections have been withdrawn.

3. Applicant's arguments, see pages 6-7, filed 5/15/08, with respect to the 102 rejection of claim 1 have been fully considered but they are not persuasive.

McDowell discloses monitoring the status of a software application ([0049]-[0050]; [0052]).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ON/OFF) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant's remaining arguments have been considered but are moot in view of the new ground(s) of rejection.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of the newly added claims (21-31) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as

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either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 21-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has failed to indicate where the support for the newly added claims is in the instant specification. Examiner has not readily found support for the newly added claims.

Claim Rejections - 35 USC § 102

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4, 6-7, and 25 are rejected under 35 U.S.C. 102(a/e) as being anticipated by McDowell et al. (McDowell), U.S. Publication No. 2002/0035605 A1.

10. As to claim 1, McDowell discloses a method for monitoring a software application in a packet-switching network (Abstract, ln. 1-4; [0050], ln. 5-8), comprising:

recording a state of the software application by a monitoring application ([0052], *especially* ln. 7-10 and 14-16);

transmitting the state to a Presence Application which indicates the state ([0049], *especially* ln. 6-8; [0052], *especially* ln. 1-2 and 7-10);

registering the software application by the monitoring application as a first communication partner in a list of communication partners accessible in the network ([0049], ln. 6 – [0050], ln. 5; [0051]; [0052], ln. 7-16);

registering the Presence Application in the list as a second communication partner which monitors the first communication partner ([0049], ln. 6 – [0050], ln. 5; [0051]; [0052], ln. 1-2 and 7-16; *especially* [0052], ln. 1-2, “The Presence Server... power[s] the buddy list.”); and

transmitting the state of the software application to the Presence Application as a characteristic which is associated with the first communication partner ([0052], ln. 7-16), wherein the monitoring is carried out on the basis of the characteristic ([0052], ln. 7-16).

11. As to claim 2, McDowell discloses a control instruction for controlling the software application is transmitted from the Presence Application to the monitoring application ([0056], ln. 4-7 and 13-15; instructions regarding other users presence are transmitted to the client in order to control how the status of the other users on the client’s buddy list presented to the client).

12. As to claim 3, McDowell discloses a presence/instant messaging system is used for monitoring application ([0056], ln. 4-7).

13. As to claim 4, McDowell discloses the transmission of the state is secured by a handshake process ([0081], ln. 5-7; [0139]; TCP/IP is known in the art to include a handshake process).

14. As to claim 6, McDowell discloses a software application can be monitored by any desired number of Presence Applications (Fig. 7; [0049], ln. 6-8), and Presence Applications can monitor any desired number of software applications ([0051]; [0056], ln. 4-7).

15. As to claim 7, McDowell discloses the monitoring application which is associated with a software application to be monitored is found and registered on the basis of the request of the Presence Application ([0056]; [0096]).

16. As to claim 25, the claim is rejected for reasons similar to claim 1 above.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell as applied to claims 1-4 above, in view of IETF; 2.1.12 SIP for Instant Messaging and Presence Leveraging (simple); 7/31/01.

19. As to claim 5, McDowell discloses the invention substantially as in parent claim 2, including the registration of the software application and the transmission of the state are carried out using an SIP infrastructure ([0139], ln. 6-12), but is silent on the SIMPLE extension to the SIP protocol.

However, IETF discloses the SIMPLE extension to the SIP protocol (Pg. 1, heading).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McDowell by expanding on the use of SIP to include the SIMPLE extension as the motivations for using both are to make use of an interoperable standard.

SIMPLE extends SIP to instant messaging and presence leveraging. As McDowell is directed to presence detection and instant messaging and discloses the use of SIP, the incorporation of SIMPLE is an obvious one in order to make use of a suite of services for

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instant messaging and presence through an interoperable standard (**Description of Working Group, ¶ 1**).

20. Claims 21-22, 24, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell as applied to claims 1-2 and 25 above, in view of Tzann-en Szeto (Szeto), U.S. Publication No. 2004/0215731 A1.

21. As to claim 21, McDowell discloses the invention substantially as in parent claim 2, including the Presence Application includes a text editor (Page 5, TABLE I, "ON - <user defined>... create arbitrary status indicators consisting of alphanumeric characters"), but is silent on the control instructions are entered into the text editor and transmitted to the monitoring application as an instant message.

However, Szeto discloses control instructions are entered into a text editor and transmitted to a monitoring application as an instant message ([0094]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McDowell by sending control instructions entered into a text editor in an instant message to a monitoring application as taught by Szeto in order to enable activities such as co-searching, co-browsing, co-drawing, games, etc. (Szeto: [0094]).

22. As to claims 22, 24, and 26-29, the claims are rejected for reasons similar to claim 21 above.

23. Claims 23 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell and Szeto as applied to claim 21 above, in view of what was well known in the art at the time of the invention.

24. As to claim 23, the claim is rejected for reasons similar to claim 21 above. It may be interpreted that in order to invoke control messages for activities such as engaging in networked games the application itself must be identified in the control messages.

Failing this, Official Notice (MPEP 2144.03) is taken that sending the name of the program in a text message is an obvious variant of the teachings of Szeto. If control messages are being sent in instant messages directed to specific applications, such as networked games, then including the name of the application itself must be done at some point in time. As Szeto is already directed to controlling applications through instant messages, performing this identification of an application in the instant message itself is extremely obvious.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McDowell and Szeto by identifying the software application in an instant message, as a person of ordinary skill in the art has good reason to

pursue the known options within his or her technical grasp. As the indication of the application must occur at some point, and control messages in an instant message already disclosed by Szeto for applications, one of ordinary skill in the art would naturally find it obvious to indicate the identification of the application in the instant message as well.

25. As to claims 30-31, the claims are rejected for reasons similar to claim 23 above. Similar to the discussion of the identification of the relevant application above, the host name/IP address must also be identified in order to communicate via instant messages, and the motivation to do such in the manner claimed is similar to the motivation given above for identifying the application.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (9:30 AM to 6:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2152
5/31/08

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